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| 10/798,462      | 03/11/2004  | Brian R. Samuels     | 29214/40015         | 6413             |

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| EXAMINER |
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PATTERSON, MARC A

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| ART UNIT | PAPER NUMBER |
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1772

DATE MAILED: 10/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/798,462 | <b>Applicant(s)</b><br>SAMUELS, BRIAN R. |  |
|                              | <b>Examiner</b><br>Marc A. Patterson | <b>Art Unit</b><br>1772                  |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 July 2006.
- 2a) ☒ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election with traverse of the restriction requirement in the reply filed on July 10, 2006 is acknowledged. The traversal is on the ground(s) that a search for Applicant's method and food product claims would necessarily encompass a search for Applicant's claims. This is not found persuasive because the product and method claims have different classifications, as stated in the restriction requirement.

The requirement is still deemed proper and is therefore made FINAL.

**WITHDRAWN REJECTIONS**

2. The 35 U.S.C. 112, second paragraph rejection of Claim 1, of record on page 2 of the previous Action, is withdrawn.

**NEW REJECTIONS**

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 – 5, 7 – 15, 17 and 42 – 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Beckwith et al (WO 97/36798).

With regard to Claims 1 – 3, Beckwith et al disclose a film having a liquid absorbed therein (a solution of a modifier, therefore a liquid, is sorbed into a film; page 15, lines 2 – 12), the surface of the film having a surface energy, therefore a dyne level, of at least 50 dynes; the liquid is applied to the surface of the film (the film is immersed in a bath of modifier; page 14, lines 22 – 25) and prior to the application of the liquid the surface has been subjected to a surface activation treatment (corona treatment, therefore corona discharge; page 13, lines 16 – 21). However, the claimed aspects of the film being treated by corona discharge prior to the application, and of the liquid application, and of the amount of liquid being able to be absorbed by the film being higher than before the surface treatment, are given little patentable weight as the limitations are directed to process limitations.

With regard to Claims 4 – 5, the claimed aspects of the film being treated by corona discharge at between 100 and 600 W-m/M<sup>2</sup> and of the liquid application, are given little patentable weight as the limitations are directed to process limitations.

With regard to Claim 7, the film disclosed by Beckwith et al is a food packaging film having a food contact surface (food contact layer used for cook – in; page 9, lines 1 – 7).

With regard to Claims 8 and 10, the liquid disclosed by Beckwith et al is absorbed into a layer comprising polyamide (ether / amide copolymer; page 10, lines 27 – 30), therefore a monolayer of polyamide.

With regard to Claims 9 and 42 – 44, the film disclosed by Beckwith et al also comprises a polyvinylpyrrolidone (page 12, line 11) and is crosslinked (page 11, line 17).

With regard to Claim 11, the film disclosed by Beckwith et al has two layers (multilayer film; page 7, lines 14 – 20) comprising a polyamide layer which is an inner layer (page 19, lines 7 – 14) and a polyolefin layer which is an outer layer (page 17, lines 7 – 9).

With regard to Claim 12, the film disclosed by Beckwith et al is in the form of a tubular casing (page 22, lines 24 – 26).

With regard to Claim 13, the Beckwith et al discloses a film having a water sorption capacity (page 9, lines 30 – 31); the liquid disclosed by Beckwith et al therefore consists essentially of water.

With regard to Claims 14 – 15 and 17, the liquid disclosed by Beckwith et al comprises a composition comprising an additive for transfer to a food product comprising a flavoring agent (liquid smoke; page 15, line 26) the liquid therefore comprises an anti – viral agent as it induces eating , and therefore destruction of the food product and thus prevents the infection of the food product with viruses.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beckwith et al (WO 97/36798).

Beckwith et al disclose film comprising a liquid which has been applied to a surface as stated above. Beckwith et al fail to disclose a liquid that is applied in amount of between 0.4 to 10 mg/cm<sup>2</sup>. However, Beckwith et al disclose a liquid that is applied in amount which provides sorption of a relatively large amount of modifier (page 15, lines 12 – 15). Therefore, one of ordinary skill in the art would have recognized the utility of varying the amount of the liquid applied to obtain the desired amount of liquid absorbed. Therefore, the amount of liquid absorbed would be readily determined by through routine optimization of the amount of the liquid applied by one having ordinary skill in the art depending on the desired use of the end product as taught by Beckwith et al.

It therefore would be obvious for one of ordinary skill in the art to vary the amount of the liquid applied in order to obtain the desired amount of liquid absorbed, since the amount of liquid absorbed would be readily determined through routine optimization by one having ordinary skill in the art depending on the desired end result as shown by Beckwith et al.

7. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beckwith et al (WO 97/36798) in view of Luthra et al (European Patent No. 0986957).

Beckwith et al disclose film for a food casing comprising a modifier, therefore an additive, as stated above. Beckwith et al fail to disclose an additive that comprises a Maillard reagent.

Luthra et al teach a film (paragraph 0001) having an additive that comprises a Maillard reagent (sugar; paragraph 0042) for a food casing (packaging for meat products; paragraph 0002) for the purpose of obtaining a food casing that provides transfer of flavor from the film

(paragraph 0001). One of ordinary skill in the art would therefore have recognized the advantage of providing for the additive of Luthra et al in Beckwith et al, which comprises film for a food casing, depending on the desired transfer of flavor of the end product.

It therefore would have been obvious for one of ordinary skill in the art at the time Applicant's invention was made to have provided for an additive that comprises a Maillard reagent in Beckwith et al in order to obtain transfer of flavor from the film as taught by Luthra et al.

#### ANSWERS TO APPLICANT'S ARGUMENTS

8. Applicant's arguments regarding the 35 U.S.C. 102(b) rejection of Claims 1 – 5, 7 – 15 and 17 as being anticipated by Beckwith et al (WO 97/36798), 35 U.S.C. 103(a) rejection of Claim 6 as being unpatentable over Beckwith et al (WO 97/36798) and 35 U.S.C. 103(a) rejection of Claim 16 as being unpatentable over Beckwith et al (WO 97/36798) in view of Luthra et al (European Patent No. 0986957), of record in the previous Action, have been carefully considered but have not been found to be persuasive for the reasons set forth below.

Applicant argues, on page 12 of the remarks dated July 10, 2006, that the claimed surface treatment, and degree of surface treatment, provides a structurally and chemically distinct film from the film disclosed by Beckwith et al.

However, as stated above, the claimed surface treatment is a process limitation and is therefore given little patentable weight; furthermore, the structural and chemical differences between the claimed film and a film that has a surface energy of at least 50 dynes without the use of surface treatment have not been claimed. Furthermore, the film disclosed by Beckwith et al

has been surface treated by corona discharge and has a surface energy of at least 50 dynes; the claimed aspect of the film being able to absorb more liquid after the treatment is inherent to Beckwith et al.

Applicant also argues, on page 12, that the water insoluble segment disclosed by Beckwith et al does not absorb the aqueous modifier.

However, Beckwith et al disclose the absorbing (sorbing; page 15, lines 10 – 15) of the modifier, which is a liquid, by the film.

Applicant also argues on page 12 that Beckwith et al disclose no relevant modification of the insoluble segment.

However, as stated above, Beckwith et al disclose the absorbing of the modifier, which is a liquid, by the film.

Applicant also argues, on page 13, that Beckwith et al disclose corona treatment to increase surface energy to increase adhesion between the film and food product.

However, Beckwith et al disclose corona treatment, as claimed.

Applicant also argues on page 13 that Beckwith et al caution against a surface energy that is too high.

However, as stated above, the claimed surface energy is disclosed.

Applicant also argues on page 13 that Beckwith et al fail to teach or suggest that a surface treatment can increase ability to absorb a liquid, and teach against it, in fact, because the water – insoluble segment disclosed by Beckwith et al is essential for absorption and does not absorb liquid but instead provides structural support.



However, as stated above, Beckwith et al disclose the absorbing (sorbing; page 15, lines 10 – 15) of the modifier, which is a liquid, by the film, and the film disclosed by Beckwith et al has been surface treated by corona discharge and has a surface energy of 50 dynes; the claimed aspect of the film being able to absorb more liquid after the treatment is inherent to Beckwith et al. Furthermore, a true ‘teaching away’ would seem to require a statement which is more direct; even if Beckwith et al disclose that the water – insoluble segment is essential for absorption of liquid into the film, and that the segment does not absorb liquid but instead provides structural support, it is not clear that Beckwith et al teach away from the use of surface treatment to increase the ability of a film to absorb a liquid.

Applicant also argues, on page 14, that one of ordinary skill in the art would understand the reference to corona treatment to refer to the instance when the water – insoluble segment is a polyolefin.

However, no water – insoluble segment is claimed.

Applicant also argues on page 14 that the exemplified films disclosed by Beckwith et al have not been corona – treated.

However, as stated above, corona treatment is disclosed by Beckwith et al.

Applicant also argues on page 14 that a film which has undergone sufficient surface activation treatment and which in turn has an increased ability to absorb a liquid, is physically and chemically different from the film of Beckwith et al.

However, as stated above, the structural and chemical differences between the claimed film and a film that has a surface energy of at least 50 dynes without the use of surface treatment

have not been claimed, and are also unclear; the surface treatment is also directed to a process limitation.

Applicant also argues, on page 15, that Beckwith et al disclose that the polyamide is not corona treated.

However, it is not unclear where Beckwith et al state that the polyamide is not corona treated.

Applicant also argues, on page 15, that Beckwith et al do not disclose a crosslinked polyvinylpyrrolidone.

However, as stated above, the film disclosed by Beckwith et al also comprises a polyvinylpyrrolidone (page 12, line 11) and is crosslinked (page 11, line 17).

Applicant also argues, on page 16, that an ingredient that induces eating does not preclude infection of the food product.

However, eating clearly precludes infection of the organism that is eating, by viruses that are caused by lack of eating.

Applicant also argues on page 16 that the food product may still become infected.

However, Beckwith et al do not disclose the infection of a food product.

Applicant also argues that Claims 6 – 7, 11 – 13 and 16 are novel and unobvious for the reasons stated above. In response, the above answers are repeated.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc A Patterson whose telephone number is 571-272-1497. The examiner can normally be reached on Mon - Fri 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1772

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Marc Patterson 10/2/06*  
Marc A. Patterson, PhD.  
Primary Examiner  
Art Unit 1772